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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,734	02/27/2004	Ramnath N. Iyer	EI-7617	6096
34769	7590	10/01/2007	EXAMINER	
NEW MARKET SERVICES CORPORATION (FORMERLY ETHYL CORPORATION)			GOLOBOY, JAMES C	
330 SOUTH 4TH STREET RICHMOND, VA 23219			ART UNIT	PAPER NUMBER
			1714	
			MAIL DATE	DELIVERY MODE
			10/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/788,734	IYER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James Goloboy	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 19 June 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-6,8-23 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6,8-23 and 25-36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Applicant's amendment of 6/19/07 overcomes the rejections under 35 USC 102 over Watts in paragraph 2 of the office action mailed 3/29/07. The rejections over Srinivasan have been maintained below, and new grounds of rejection for the claims not previously rejected over Srinivasan, necessitated by applicant's amendment, are also set forth below.

***Claim Rejections - 35 USC § 102***

2. Claims 1-4, 6, 8-10, 12-16, 18-19, 22-23, 25, 27, 29-32, and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Srinivasan.

This rejection is adequately set forth in paragraph 3 of the office action mailed 3/29/07, which is incorporated here by reference. Amended claim 1 is equivalent to original claim 7.

***Claim Rejections - 35 USC § 103***

3. Claims 5, 8, 11, 17, 21, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan.

This rejection is adequately set forth in paragraph 4 of the office action mailed 3/29/07, which is incorporated here by reference.

4. Claims 20 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan in view of Watts.

The rejections of claims 20 and 33 are adequately set forth in paragraph 5 of the office action mailed 3/29/07, which is incorporated here by reference.

5. Claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Srinivasan.

Claim 26 depends on claim 12, which has been amended to require that the fluid composition be free of dispersant viscosity index improver (VII). Watts teaches a method of lubricating a power transmission with a fluid that contains a non-dispersant VII, but can also contain a dispersant VII. As discussed in paragraph 3 of the office action mailed 3/29/07, which is incorporated by reference above, Srinivasan discloses an automatic transmission fluid requiring only a non dispersant VII. Therefore, it would have been obvious to one of ordinary skill in the art that the power transmission fluid of Watts could be used without the further addition of a dispersant VII, meeting the limitations of claim 26.

#### ***Response to Arguments***

6. Applicant's arguments filed 6/19/07 have been fully considered but they are not persuasive. Applicant argues that paragraph 101 of Srinivasan discloses the preferred use of a dispersant polymethacrylate VII or a mixture of dispersant and non-dispersant VII. However, paragraph 101 clearly also discloses a non-dispersant VII by itself as a preferred VII. Applicant also argues that one of skill in the art would not be led toward

selecting the non-dispersant VII or explicitly excluding a dispersant VII, but this is not necessary for a rejection under 35 USC 102.

Applicant additionally argues that Srinivasan attributes shear stability and elastomeric compatibility to components other than the non-dispersant VII. This argument is relevant to claims 22-23 and 36. As discussed in paragraph 3 of the office action mailed 3/29/07, it is the examiner's position that the composition of Srinivasan, meeting the structural limitations of claims 22-23 and 36, must also provide the improved compatibility recited in those claims.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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